



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*SW*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,038	03/05/2002	Teemu Puskala	4925-84CIP	8149

7590 12/06/2004

Michael C. Stuart, Esq.  
Cohen, Pontani, Lieberman & Pavane  
Suite 1210  
551 Fifth Avenue  
New York, NY 10176

EXAMINER
----------

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/091,038

**Applicant(s)**

PUSKALA, TEEMU

**Examiner**

John M Hotaling II

**Art Unit**

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/25/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 7, 8, 11-21, AND 23-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Eck et al US Patent 6,716,103. With respect to claims 1-5, 7, 16 and 31 Eck discloses a portable hand held wireless gaming device in connection with a service provider that communicates through the service provider along with an interactive program, such as a game, and that the means for transmitting a message is address selectable (see columns 1, 2, 9-12, 16, 25-27). The messages can be sent from the host to the plurality of pagers, from pager to pager which is address selectable (address book, gaming center column 12). With respect to the claim limitations of claims 7, 8, and 33 please see column 13 lines 1-40. With respect to claims 11 and 26 please see

Art Unit: 3713

where the indicator is made available in column 10:65-11:7. With respect to a automatic or automated message see 15:47-16:7. With respect to claims 13,14,28,29,36, and 37 where the interactive message is stored in and retrieved from a storage device in the wireless terminal or in the service platform Columns 3-6 discloses the memory and memory devices column 12 discloses that the message may be composed from the paging memory on the paging device and where the it is stored depends on if the message comes from the pager device or the platform. With respect to claim 15 voice text sound etc please see column 6 lines 19-24.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck et al US Patent 6,716,103 as applied to the claims above in view of Jamtgaard et al US Patent 6,430,624. Eck discloses all of the instant application as disclosed above. Eck does not specifically state that there are means for assessing the output capability and means for configuring the message to match the output capability of the other terminal would be taken into consideration. Eck does disclose in columns 25 and 26 that various types of other wireless technologies can be used. In an analogous information content delivery system, Jamtgaard discloses that it is known to have a

Art Unit: 3713

content delivery system and method in which different types of content may be delivered to different information appliances having different protocols and different browser specifications. The system also delivers Web-based content, commerce, enabling transactions, and services to a variety of information appliances and devices without requiring the re-authoring of the content information for display on each of these different devices. Additionally, the system allows the formatted content to be output in and mark-up language and protocol, such as WML, HTML, HDML, XML, etc. and can be optimally formatted for display on the devices according to the input/output format, such as the display screen size parameters of the devices. It would be obvious to one of ordinary skill in the art at the time of the invention to combine the game system of Eck which transmits messages to multiple types of other wireless technologies with the known delivery system of Jamtgaard which discloses content delivery system and method in which different types of content may be delivered to different information appliances having different protocols and different browser specifications. Jamtgaard discloses that it is known to have a content delivery system and method in which different types of content may be delivered to different information appliances having different protocols and different browser specifications. One would be motivated to make this combination since Eck teaches that messages may be transferred and used by a plurality of other wireless technologies.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck et al US Patent 6,716,103. Eck does not specifically disclose the wireless device may be a mobile phone or have a specific button to send a message. Instead

Eck discloses in columns 26 and 27 that the present invention may be applied to other wireless technologies such as GSM and WAP both of which are usually associated with cell phones. With respect to a button to send a message the use of a send button is inherent to the use of any two way type messaging device and as such must be present. With respect to a particular button and or placement this would be an obvious matter of choice well within the capabilities of one skilled in the art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DeLuca '717 discloses a message apparatus for selective message transmissions

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II  
PRIMARY EXAMINER

December 1, 2004

